

REMARKS

The Office Action dated February 25, 1993 has been carefully considered. Allowance of this Application, as amended, is respectfully requested.

In the Office Action, the claim was rejected as nonstatutory matter under 35 U.S.C. § 171 as not being directed toward an article; Ex Parte Tayama, 24 USPQ2d 1614 (1992) is cited in support of the rejection of the claim. All other issues relevant to the Application have been deferred pending resolution of the rejection of the claim under 35 U.S.C. § 171.

To summarize the present Amendment, the drawings are amended to include matter expressly described in the specification and claim, by adding the referenced computer display to each of Figures 1-9. This amendment to the drawings, submitted in accordance with 37 C. F. R. § 1.117 to insure uniformity between the specification and drawings, demonstrates in the drawings the use of Applicants' icon on the claimed article, namely a representative computer display.

Although amendment of the drawings may not be necessary to further clarify that a "computer display" is the relevant article to which the design of the icon may be applied, Applicant has amended the drawings to provide such clarification. The Office action states that "Applicant is advised that any supplemental disclosure of an article to which the the design might be applied would be new matter under 35 USC 132 and 37 C.F.R. 1.118." Applicant respectfully submits that the article to which the design may be applied, namely, a "computer display," is already expressly disclosed in the originally filed specification and claim. As such, proper amendment of the drawings to include this originally disclosed "computer display" is permitted under U.S.P.T.O. rules, and is not new matter prohibited by 35 USC § 132.

Applicants in the present case have once in the title, nine times in the specification, once in the claim and "with reference being had to the accompanying drawings," expressly set forth a "computer display" as being

the article required by 35 U.S.C. § 171. These multiple cross references are more than sufficient to establish a "computer display" as the specific relevant article. The U.S.P.T.O suspended the prosecution of a number of computer display icon design patent cases pending resolution of the issue of whether an icon on a computer display constitutes patentable subject matter under 35 U.S.C. § 171. In Ex parte Strijland, Appeal No. 92-1623 (Board of Patent Appeals and Interferences; April 2, 1992), the Board determined that in such applications when the intended design is an integral and active component in a computer displaying the design, "the subject matter, if properly presented and claimed would have constituted statutory subject matter under 35 U.S.C. § 171." Strijland, at 12.

Applicant notes the Board refused to permit the applicant in Tayama to amend its application after filing to include a new, previously undisclosed article; in fact, the applicant in Tayama failed to specify any article of manufacture as is required by the 35 U.S.C. § 171. (See the specification recounted in full in Tayama at 615, n. 1.). The Tayama Board understandably could not even find an implication that the applicant's design was intended to include any article of manufacture, as "[m]ore than an applicant's generalized intent to ornament some article is required." Tayama, at 1617. As such, the Board in Tayama determined with no mention or implication of any article in the original specification or claims, the applicant's subsequent attempts to name an article would not be permitted. It is this shortcoming that the Board found to be the fatal flaw in the Tayama application; the Board did not conclude or suggest that an originally claimed and disclosed article may not be the subject of a properly executed drawing amendment. On the contrary, the Board opined that "[i]n order to meet this threshold requirement of an applied design, we conclude that an applicant's specification must expressly disclose some article of manufacture ornamented by the design[;] . . . Applicant's specification does not show or describe the claimed design embodied in any article of manufacture." Tayama, at 1616-17 (emphasis added).


The present application as amended satisfies the prerequisites of a design patent application as enumerated in Ex parte Strijland, namely that a graphic icon constitutes statutory subject matter if the claim indicates that the icon is for a display screen and if the drawings show the article on which the graphic icon is used. The drawings demonstrate clearly the representative article upon which the inventive design is employed, and the specification and claims expressly include the article, a "computer display." Applicant is not required to include an entire computer or the like in the figures; even a graphic representation of a portion of the article is sufficient. "While the design must be embodied in some article, the statute is not limited to designs for complete articles, or 'discrete' articles, and certainly not to articles separately sold..." Ex Parte Tayama, at 1617, quoting In re Zahn, 204 USPQ 988, 995 (CCPA 1980).

Applicant's amended drawings add no new matter and are otherwise permissible according to the pertinent rules governing such amendments, namely 37 C. F. R. §§ 1.83, 1.117 and 1.118. Rule 183 requires that the drawings include the claimed features, except that conventional or nonessential features "should be illustrated in the drawing in the form of of a graphical drawing symbol or a labeled representation." Rule 117 requires the the "specification, claims and drawings must be amended and revised when required, . . . and to secure correspondence between the claims, the specification and the drawing" Lastly, Rule 118 states that "[a]ll amendments to the specification, including the claims, and the drawings filed after the filing date of the application must conform to at least one of them as it was at the time of the filing of the application." The present application discloses the article in the specification and claims; as such, the plain meaning of Rules 1.83, 1.117 and 1.118 permit the drawings to be amended in the manner presented by Applicants. Applicant submits that the drawing amendments of the originally disclosed "computer display" are particularly unobjectionable, in that the representative article is not part of the claimed icon design and is not related to any utility aspect of the invention as might be the case with a utility application.

In summary, Applicants seek to amend the drawings in a manner that is consistent with the rules since the present amendment does no more than correlate the drawings to the originally filed specification and claims. It is respectfully submitted that, as amended, the present application is now clarified to include all statutory matter required by 35 U. S. C. § 171. In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited.

In the event the Examiner believes that telephone contact will assist in the disposition of this case, Applicants request that she call the undersigned attorney at (716) 423-5560.

Respectfully submitted,



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May 21, 1993

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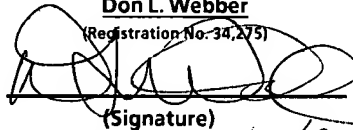
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